

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 29, 2008 has been entered.

The Examiner acknowledges the applicant's remarks and arguments of July 29, 2008 made to the office action filed January 29, 2008. Claims 20-22, 24-29 and 54-56 are pending. Claims 20 and 27 are amended and claims 54-56 are new. Claims 1-19 and 30-53 are cancelled.

In light of the amendments and cancellation of the claims, the following rejections and objections are withdrawn: 1) the 35 U.S.C. 112, first paragraph rejection of claim 20; 2) the 35 U.S.C. 112, second paragraph rejection of claims 12-14 and 17-19; and 3) the 35 U.S.C. 112, second paragraph rejection of claims 20-22.

Due to the amendment to the claims, the new objection and obvious double patenting rejections are made below. Applicant's arguments with respect to claims 24-29 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 55 and 56 are allowed.

Claim Objections

Claims 24-29 and 54 are objected to as being dependent upon a rejected base claim, but would be allowable if Formula (III) is not included in the claim, or a terminal disclosure is provided for US Patent No. 7288546.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 7288546 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Patent 7288546 teaches a method of inhibiting Omi/HtrA2 comprising reaction the protein with a compound of formula disclosed in claim 1.

Patent 7288546 does not teach the exact compound of the current application.

To one of ordinary skill in the art at the time of the invention would have found it obvious to inhibit Omi/HtrA2 with the compound disclosed in claim 1 of patent 7288546 because the compound of Formula (III) in claim 20 of the present invention is a positional isomer of the compound in patent 7288546. Particularly, the nitro group is ortho to the oxazole group in patent 7288546 and the nitro group is meta to the oxazole group in the present application. A novel useful compound that is isomeric with the prior art compound is unpatentable unless it possesses some unobvious or unexpected

beneficial property not possessed by the prior art compound. In re Norris, 179 F.2d 970, 84 U.S.P.Q. 458 (C.C.P.A. 1970).

Conclusion

Claims 55 and 56 are allowable, whereas claims 20-22, 24-29 and 54 would be allowable by removing Formula (III) in claim 20 or by filling a terminal disclosure over US Patent No. 7288546.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENDRA D. CARTER whose telephone number is (571)272-9034. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/728,056
Art Unit: 1617

Page 6

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. D. C./
Examiner, Art Unit 1617

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1617